



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

more Application of
Mooney et al.

Serial No.: 09/492,398

Filed: January 27, 2000

For: Method of Supplying and Dispensing
Prescribed Medical Supplies Through a Web
Site Associated with a Medical Care Provider

Docket No: 4333-003

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

) PATENT PENDING

) Examiner: Mr. Samuel G. Rimell

) Group Art Unit: 2166

) Confirmation No.:9822

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

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transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

May 4, 2006

Date

Kathleen Keppen
Kathleen Keppen

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF DATED APRIL 17, 2006

Sir:

This paper is being filed in reply to the Notice of Non-Compliant Appeal Brief mailed April 17, 2006. No fees should be required for entry of this paper. However, if any fees are required or due for entry of this paper, the Commissioner is authorized to charge them to Deposit Account 18-1167.

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REMARKS

In the notice of non-compliance, the Examiner deems Applicant's Revised Appeal Brief of May 19, 2005 to be unacceptable because it complies with the format set forth in 37 C.F.R. §1.192(c) and not 37 C.F.R. §41.37(c). The Examiner, however, is incorrect. According to section A of the Clarification of the Effective Date Provision issued by the U.S.P.T.O. (Exhibit 1), amended Briefs filed on or after September 13, 2004 are properly submitted in either format ***so long as*** the original Appeal Brief was filed prior to September 13, 2004.

A6. If an appeal brief filed before the effective date of September 13, 2004 fails to comply with the content and format requirements of § 1.192 and the Office mails appellant a Notice that correction is required, would an amended appeal brief filed on or after the effective date be required to be in compliance with § 41.37(c)?

No, an amended appeal brief, based on an appeal brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former § 1.192 or § 41.37(c), regardless of when the Office mailed a Notice requiring correction of the noncompliant appeal brief.

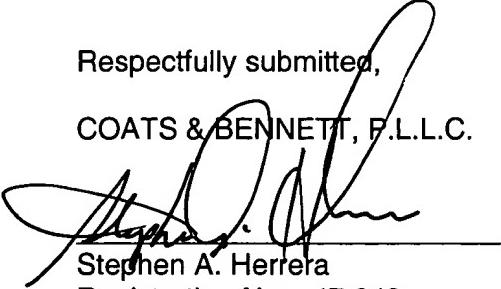
Exhibit 1, p. 3, A6 (emphasis added). Mr. Kery Fries, the Senior Legal Advisor in the Office of Patent Legal Administration, has graciously confirmed this fact in a telephone call with the undersigned agent dated May 3, 2006.

In the instant case, the Revised Appeal Brief dated May 19, 2005 is based on an Appeal Brief originally filed on July 14, 2004. Because July 14, 2004 is well before the effective date of September 13, 2004, the Revised Brief of May 19, 2005 is proper even though it conforms to the format set forth by §1.192(c).

Accordingly, the Examiner is requested to allow all pending claims or withdraw the current notice of non-compliance, accept the Revised Brief of May 19, 2005 in its current format, and continue prosecution of this case.

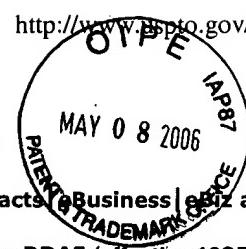
Respectfully submitted,

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Dated: May 4, 2006

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tabbed

A. **Effective Date** (September 13, 2004); A11 added 19Oct2004; A12 added 4Jan2005.

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B. **Time Periods for Filing Appeal Brief and Response to Examiner's Answer**

C. **Amendments and Affidavits or Other Evidence** (§ 1.116 and § 41.33); C7, C8 and C9 added 9Sept2005

D. **Notice of Appeal** (§ 41.31); D3 updated 4Jan2005.

E. **Appeal Brief** (§ 41.37)

F. **Examiner's Answer (Including New Ground of Rejection)** (§ 41.39)

G. **Reply Brief** (§41.41)

H. **Supplemental Examiner's Answer** (§ 41.43)

I. **Other Topics**

A. Effective Date (September 13, 2004)

Questions related to Time Periods for Filing of Papers:

A1. If a notice of appeal is filed before September 13, 2004, the effective date of the BPAI final rule, when is the appeal brief due?

If the notice of appeal is filed before September 13, 2004, the time period for filing an appeal brief will be the time period set forth in former § 1.192(a) which provides that the appellant must file an appeal brief: (1) within two months from the date of filing of the notice of appeal; or (2) within the time allowed for reply to the action from which the appeal was taken, if such time is later.

The time period set forth in former § 1.192(a) also applies if the notice of appeal is filed with a certificate of mailing or transmission in compliance with § 1.8 and the date on the certificate of mailing or transmission is before the effective date of September 13, 2004, but the notice of appeal is received by the Office on or after September 13, 2004. The two month time period will begin on the date of receipt of the notice of appeal.

A2. If appellant reinstates the appeal after the prosecution is reopened by filing a second notice of appeal on or after the effective date, when is the second appeal brief due?

Appellant must file the second appeal brief (in compliance with the format and content requirements of § 41.37(c)) within two months from the date of filing the second notice of appeal, even if the first notice of appeal and the first brief were filed before the effective date. The two month time period is extendable under the provisions of § 1.136 for patent applications and § 1.550(c) for *ex parte* reexamination proceedings. See § 41.37(e).

A3. If a notice of appeal is filed on or after the effective date of September 13, 2004, would extensions of time under § 1.136(a) be required when a Request for Continued Examination (RCE) under § 1.114 or an amendment is filed after two months from the date of filing the notice of appeal, but within three months from the mailing of the action from which the appeal was taken?

Yes, extensions of time under § 1.136(a) are required for filing an RCE or amendment after two months from the filing of the notice of appeal, even if the RCE or amendment is filed within the three months from the mailing of the action from which the appeal was taken.

Questions related to Appeal Brief Contents or Requirements for Papers Filed after Appeal:

A4. If the notice of appeal is filed before the effective date of September 13, 2004 and the brief is filed by appellant on or after the effective date, would the appeal brief be required to comply with the

content and format requirements of § 41.37(c)?

Yes, any appeal brief filed on or after September 13, 2004 must be in compliance with the requirements set forth in § 41.37(c) and be accompanied by the appropriate fee under § 41.20(b)(2). If the brief does not comply with § 41.37(c), an amended brief will be required under § 41.37(d).

Exception: If the appeal brief is filed with a certificate of mailing or transmission under § 1.8 and the date on the certificate of mailing or transmission is before September 13, 2004, the appeal brief may comply with either former § 1.192 or new § 41.37, even if the appeal brief is received by the Office on or after September 13, 2004.

A5. Would the Office accept an appeal brief filed before the effective date of September 13, 2004 that is in compliance with § 41.37(c)?

Yes, a brief filed before September 13, 2004 that is compliant with the new § 41.37(c) will be acceptable.

A6. If an appeal brief filed before the effective date of September 13, 2004 fails to comply with the content and format requirements of § 1.192 and the Office mails appellant a Notice that correction is required, would an amended appeal brief filed on or after the effective date be required to be in compliance with § 41.37(c)?

No, an amended appeal brief, based on an appeal brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former § 1.192 or § 41.37(c), regardless of when the Office mailed a Notice requiring correction of the noncompliant appeal brief.

A7. If, after a final rejection or an appeal, applicant or appellant files an amendment, affidavit or other evidence on or after the effective date, will the revised or new rules in the BPAI Final Rule apply?

Any affidavit or other evidence filed after a final rejection, or an appeal, on or after the effective date, will be subject to the revised or new rules (*i.e.*, the revised § 1.116 or new § 41.33).

Questions related to Examiner's Answers and Supplemental Examiner's Answers:

A8. If the appeal brief is filed before the effective date of September 13, 2004, but the examiner's answer is mailed on or after the effective date, can the examiner's answer include a new ground of rejection?

Yes, an examiner's answer mailed on or after September 13, 2004 may include a new ground of rejection (with Technology Center Director or designee approval) in compliance with § 41.39. Any examiner's answer mailed before September 13, 2004, however, may not include a new ground of rejection. See former § 1.193.

A9. Can the examiner provide a supplemental examiner's answer under § 41.43 on or after the effective date of September 13, 2004 in response to any new issue raised in a reply brief that was filed before the effective date?

Yes, the examiner may provide a supplemental examiner's answer (with Technology Center Director or designee approval) if it is mailed on or after September 13, 2004 in response to any new issue raised in a reply brief, even if the reply brief was filed before September 13, 2004. Appellant may file another reply brief in compliance with § 41.41 to reply to the supplemental examiner's answer within two months from the date of mailing of the supplemental examiner's answer. Extensions of time under § 1.136(a) are not applicable to the two-month time period.

A10. If the Board remanded an application before the effective date of September 13, 2004 for further consideration of a rejection, and the examiner provides a supplemental examiner's answer on or after the effective date (in response to the remand by the Board), can appellant request that prosecution be reopened under § 41.50(a)(2)(i)?

No, appellant may **not** request that prosecution be reopened under § 41.50(a)(2)(i) in response to the supplemental examiner's answer since the Board remanded the application before the effective date.